

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-30 remain in this application. The Examiner has allowed claims 1, 3-11, 13-25, and 29-30. Claims 2 and 12 have been amended to include limitations already added to claims 1 and 11, respectively, and thus the amendments do not raise any new issues.

The Examiner objected to claims 26 and 27 for being dependent upon a rejected parent claim. The parent claim has been amended, and is patentable for the reasons discussed below.

Claims 2, 12, and 28 were rejected under 35 U.S.C. §102(a) as being anticipated by admitted prior art. For the following reasons, the rejections are respectfully traversed.

Claim 2, has been amended in the manner that claim 1 has been previously amended to recite a "multiband data communication apparatus" which transmits signals by "switching a plurality of frequency bands in response to a *band switching signal*", with the apparatus comprising "phase shifting means for *inputting* said band switching signal..." (emphasis added). Claim 12 has been amended to recite similar limitations (as claim 11 was previously amended).

The Examiner cites Figure 12 of the application as being admitted prior art, and as teaching claim 2. However, even if figure 12 is considered prior art, the figure, along with its accompanying text, does not show any phase shifting means *inputting* a band switching signal, as was discussed at the personal interview previously conducted with the Examiner. The Examiner, in the Office action, cites input 153 as being a "band switching signal". However, even if so considered, there is no teaching that the signal 153 is *input* to the phase shifters shown in the figure. In fact, it is clear from the diagram that the phase shifting is not based upon anything at all, but is instead always performed (note that the output of oscillators

111, 611, are continuously input into shifters 1209, 1219, whose outputs are continuously input into mixers 109, 110 and 609, 610, respectively), as discussed at the interview held previously with the Examiner. Contrast this with figure 6 of the application, which shows signal 653, decoded by DEC 607, operating on switch 614, which then determines the phase shift of the signal being input to mixer 610.

Consequently, for at least the above reasons, claim 2 is patentable over Fig 12. Claim 12 is thus also patentable over figure 12 for at least the same reasons. Because the Otaka reference does not overcome the shortcomings of Fig. 12, the remaining claims, which depend on one of claims 2 and 12, are also patentable over the combination of Fig. 12 with Otaka.

Furthermore, the Examiner has not provided the proper motivation for modifying figure 12 according to Otaka. The Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references can be modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the *desirability* of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is also not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner has cited no support for any such suggestion or motivation for the modification from within Otaka, and the examiner clearly cannot rely on the application, because that would apply improper hindsight motivation. Accordingly, Otaka is not properly combined with figure 12.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is encouraged to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/535,303
Amdt. Dated June 8, 2005
Reply to Office action of March 21, 2005.

If there are any additional fees resulting from this communication, please charge same
to our Deposit Account No. 16-0820, our Order No. 32430.

Respectfully submitted,

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